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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,279	03/06/2002	Thomas Martin	24903	4653

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EXAMINER
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FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/070279

Applicant(s)

Martin

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) 1-10 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

This application contains claims directed to patentably distinct species of the claimed invention. See claim 1.

Formula (I) is huge. Some method of restricting the application must be arrived at.

The variation of A3, A4 and M place the claims in many different classes, not to mention subclasses.

What we need here is the election of a species with a fixed heterocyclic ring core, from which a genus can be constructed, in the manner of *In re Harnisch*, 206 USPQ 300, at pages 305 and 306 where coumarin was the central Heterocyclic ring core from which a genus could be constructed around.

Here, nothing is constant. We need an election of a constant heterocyclic ring core.

See claim 5, here. A constant piperazine would let us construct a genus that was examinable in the time provided.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 2913

Should applicant traverse on the ground that the species are not now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Claim 1 is generic to a plurality of patentably distinct species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even if this requirement is traversed. See 37 CFR 1.143.

Claim 9 is non-statutory, as a medicament is not a pharmaceutical composition or a method claim.

Claim 10 violates 35 U.S.C. 101 and 35 U.S.C. 112, since it is drafted in terms of use. See *Clinical Products vs. Brenner*, 255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966).

J. M. Ford:jmr  
October 02, 2003



JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT

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